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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,708	08/31/2000	Oscar Lee Avant	08049.0012	3485

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EXAMINER

SCHLAK, DANIEL K

ART UNIT PAPER NUMBER

3653

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/652,708

Applicant(s)

AVANT ET AL.

Examiner

Daniel K Schlak

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*MLW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-113 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 85-113 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4,8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Election/Restrictions*

As no rejections were made under art of the independent claims of Group II, all Group II claims have been examined, the Species requirement being moot. Claims 15-84 are being considered in this office action, Claims 1-14 and 85-113 having been removed previously due to prior restriction requirement, to which no successful traverse was made and which clearly find better residence in a separately published patent document, and which are not treated in the reasons for allowance of this action, the primary reason for allowance of claims 15-84 not being recited in the other groups. Many other elements of Groups I and III were not searched in the search on the elected invention. However, much art retrieved and cited herein is of pertinence thereto.

### *Claim Objections*

Claims 18, 31, 34, 53, 61, and 70 are objected to because of the following informalities:

Claims 18, 34, 53, and 70 repetitiously recite the word "transistor".

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Claim 31, in line 2 and in line 6, recites "configure to..." The word "configure" should be changed to "configured" to make the recitation recite "configured to" which is more appropriate for the context within which it resides.

Claim 61 is an exact duplicate of claim 59. It must be removed.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 16, 31, 47, 48, 49, 51, 66, 68, 83, and 84 (and therefore all claims of Group II, by dependency) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitation "the scanned identification code" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the signal" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 31 recites the limitation "the scanned identification code" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim.

Claim 32 recites the limitation "the signal" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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Claim 47 recites the limitation "the scanned identification code" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 48 recites the limitation "the scanned identification code" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim.

Claim 49 recites the limitation "the scanned identification code" in 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 51 recites the limitation "the signal" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 66 recites the limitation "the scanned identification code" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim 68 recites the limitation "the signal" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 83 recites the limitation "the scanned identification code" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 84 recites the limitation "the scanned identification code" in line 10. There is insufficient antecedent basis for this limitation in the claim.

***Allowable Subject Matter***

No art rejections have been made to claims 15-84. They will be allowable once the indefiniteness has been removed to comply with 35 U.S.C. 112, 2<sup>nd</sup> Paragraph.

US 3,953,730 to Henry et al. (hereafter "Henry") teaches illuminating a light source to scan an identification code form a mailpiece, and sending an image of the

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scanned identification code via a fiber bundle to align filter and converting the signal, transmitting it to a microprocessor, and processing the signal to obtain the identification code. Henry does not teach an infrared receiver. Henry does not teach focusing an image of the identification code at the fiber bundle.

Henry's device is for scanning mail. A combination of Henry with any of the myriad references in existence which teach infrared receivers for detecting mailpieces could easily be made. However, to suggest this combination, allege it in rejection, and to subsequently allege the interposition of a focusing element between the mailpieces of Henry and the fiber elements of Henry, is simply not called for by Henry nor is it called for by any mailpiece scanning configuration known to the Examiner or retrieved in the search which use optical waveguides. Perkins '590 for example combines an attempt to focus reflected image light onto a fiber bundle, but the environment in which Perkins is practiced does not lend the reference as prior art for consideration of such a combination.

The scanner of Pippin et al. '336 could be replaced without undue modification, and likely the doing of such would be obvious, by the scanner of Henry and even the processing logic associated therewith. However, still some suggestion to focus the image of the code onto the fiber bundle would be required, and none is to be found among the references of this hypothetical combination.

In summary, the entire combination of infrared receiver, fiber bundle, and an effort to focus a mailpiece identification code onto the fiber bundle (Henry does not attempt to focus the image, merely capturing it directly via fiber ends being adjacent the

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envelope surfaces), would require three references, the third of which, comprising the focusing element and being, as discussed above, chosen from among art not pertaining to mail sorting, resists combination by the failure of any of the three references to explicitly put forth motivation for the introduction of the third reference.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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